

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

By the foregoing amendment, claims 1 and 8 have been amended. Thus, claims 1-14 are currently pending in the application and subject to examination.

In the Office Action mailed March 8, 2004, the Examiner objected to the title of ✓ the invention as not being descriptive. The title is amended responsive to this objection. Withdrawal of the objection is therefore requested.

The Examiner objected to claims 4 and 11 as needing further elaboration for the recited "determination means." Applicants respectfully note that the "determination means" recited in claims 4 and 11 is the servo signal processing circuit 19 shown in Fig. 1, which can determine a positional relationship between the pickup and a target position since it generates servo signals for conducting a control such as tracking servo control on the pickup. See specification page 22, lines 14-21. Withdrawal of the objection is respectfully requested.

The Examiner objected to claims 1 and 8 as needing further elaboration of the patentable distinction between them, as they are identical in every respect except for their different introductory phrases, respectively reciting a "write device" and a "read device." Applicants respectfully note that claim 1 is directed to a write device, whereas ✓ claim 8 is directed to a read device, so they are directed to two different subjects and thus are not objectionable, although they have the same structure. Withdrawal of the objection is respectfully requested. ✓

The Examiner rejected claims 4 and 11 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. As noted above with respect to the objection to claims 4 and 11, the “determination means” recited in claims 4 and 11 is the servo signal processing circuit 19 shown in Fig. 1, which can determine a positional relationship between the pickup and a target position since it generates servo signals for conducting a control such as tracking servo control on the pickup. [See specification page 22, lines 14-21. Therefore, Applicants submit that claims 4 and 11 are in compliance with U.S. patent practice, and respectfully request the withdrawal of the rejection under 35 U.S.C. § 112.]

The Examiner rejected claims 1-3, 5-10, and 12-14 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,671,199 to Nishikawa or its EP equivalent, EP 0704841. Claims 1 and 8 have been amended. To the extent that the rejection remains applicable to the claims currently pending, Applicants hereby traverse the rejection as follows.

Applicants submit that Nishikawa (or its equivalent, EP 0704841) does not describe or suggest at least the limitation of an “optical system means . . . wherein said optical system means further includes at least one additional light spot, non-collinear with said at least two light spots,” as claimed in claims 1 and 8, as amended.

For at least this reason, Applicants submit that claims 1 and 8, as amended, are allowable over the cited prior art. As claims 1 and 8, are allowable, Applicants submit that claims 2-7 and 9-14, which depend from allowable claims 1 and 8, are likewise allowable over the cited prior art.

The Examiner rejected claims 1-3, 7-10, and 14 under 35 U.S.C. § 102(b) as being anticipated by JP 05-101420. Claims 1 and 8 have been amended. To the extent that the rejection remains applicable to the claims currently pending, Applicants hereby traverse the rejection as follows.

With regard to the anticipation rejection over JP 05-101420, the Examiner indicates only that “[a]s noted in the abstract thereof as identified in the accompanying submitted search report, the limitations of these claims are met. No further analysis is made.” See Office Action, at 3.

Applicants respectfully point out that citation of and reliance upon an abstract without citation of and reliance upon the underlying scientific document is generally inappropriate where both the abstract and the underlying document are prior art. See MPEP § 706.02 (citing *Ex Parte Jones*, 62 U.S.P.Q.2d 1206, 1208 (Bd. Pat. App. & Inter. 2001)(unpublished)).

In addition, in making the rejection, the Examiner does not specifically indicate the features in JP 05-101420 that correspond to each and every element of claims 1-3, 7-10, and 14 of the present invention. A review of the abstract of JP 05-101420 fails to reveal what the Examiner views as the features corresponding to each and every element of claims 1-3, 7-10, and 14 of the present invention. Because the Examiner does not indicate the features in JP 05-101420 that correspond to each and every element of claims 1-3, 7-10, and 14, Applicants respectfully submit that the Examiner has not made a proper *prima facie* case of anticipation of claims 1-3, 7-10, and 14 of the present invention.

Furthermore, Applicants submit that JP 05-101420 does not describe or suggest at least the limitation of an “optical system means . . . wherein said optical system means further includes at least one additional light spot, non-collinear with said at least two light spots,” as claimed in claims 1 and 8, as amended.

For at least these reasons, Applicants submit that claims 1 and 8, as amended, are allowable over the cited prior art. As claims 1 and 8, are allowable, Applicants submit that claims 2-7 and 9-14, which depend from allowable claims 1 and 8, are likewise allowable over the cited prior art.

For all of the above reasons, it is respectfully submitted that the claims now pending patentably distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is encouraged to telephone the undersigned representative at the number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The fee for this extension may be charged to our Deposit Account No. 01-2300, referring to client-matter number 107156-00021.

The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referring to client-matter number 107156-00021.

Respectfully submitted,

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